



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,924	08/26/1999	JUNICHI MORI	35.C13749	7190

5514 7590 05/29/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
----------	--------------

2624

DATE MAILED: 05/29/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/383,924

Applicant(s)

MORI, JUNICHI

Examiner

Douglas Q. Tran

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Art Unit: 2624

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Nishiwaki (US Patent No. RE37,031 E) and Mandel (US Patent No. 5,435,544).

As to claim 1, Nishiwaki teaches a printing system in which a host device (2 in fig. 1) and a printer (6 in fig. 1) are connected via a communication medium and a print job produced in the host device is transferred to the printer to execute printing, comprising:

Memory means (i.e., RAM) in which paper output place information (ID of selected bin 123) on the paper output place (bin 123) used in the print job is registered (col. 5, lines 65-67 and steps of S3 and S5; note: the print job is assigned with personal ID number to ID of selected bin 123, col. 6, line 47 and 57);

Retrieval means (i.e., 101 in fig. 2) for retrieving paper output place information on a designated print job from the memory means; and Information means (i.e., 102 in fig. 2) for informing the paper output place information on the designated print job obtained in retrieving step, to the user, in response to issue of the request in the step of issuing the request (col. 5, line 66 to col. 6, line 6 and lines 58-59; from information in RAM 106, the information is retrieved and informed to the host device);

Art Unit: 2624

requisition means for requesting the status of locks and bins (in fig. 6, the printer unit send inquiry signal to mailbox unit and receiving status of locks and bins).

However, Nishiwaki does not teach requisition means for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user.

Mandel teaches requisition means for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user (in fig. 6 indicates the step of “does the user have a pre-assigned bin for this Mailbox/Fin.”; and step of “ will the new job fit entirely into this bin” and then step of “ Assign all sets to the user’s pre-assigned bin”).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printing system of Nishiwaki for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user as taught by Mandel. The suggestion for modifying the printing system of Nishiwaki can be reasoned by one of ordinary skill in the art as set forth above by Mandel because the modified printer of Nishiwaki would increase the efficiency of the printer for accepting the assigned bin from the user’s print job. The resultant system would have ability to perform either accepting the assigned bin from the user’s print job or assigning bin for the user’s print job.

As to claim 2, Nishiwaki teaches detection means for detecting papers stacked on the paper output place of the printer, and elimination means for eliminating information on the print job having used the corresponding paper output place from the memory means when the

detection means detects that papers have been removed from the paper output place (in step of S1 in fig. 5 and col. 7, lines 31-37 describes that the data in table shows the bin is available when the bin contains no the printouts).

As to claim 3, Nishiwaki teaches the memory means or retrieval means is provided in the printer (col. 5, line 66 to col. 6, line 2).

As to claim 4, Nishiwaki teaches the memory means or retrieval means is provided in the host device (col. 6, line 3).

As to claim 5, Nishiwaki teaches a method for controlling a printing system in which a host device (2 in fig. 1) and a printer (6 in fig. 1) are connected via a communication medium and a print job produced in the host device is transferred to the printer to execute printing, comprising:

registering paper output place information (ID of selected bin 123) on the paper output place (bin 123) used in the print job in memory (col. 5, lines 65-67 and steps of S3 and S5; note: the print job is assigned with personal ID number to ID of selected bin 123, col. 6, line 47 and 57);

retrieving paper output place information on a designated print job from the memory means; and informing of the paper output place information on the designated print job obtained by the retrieval (col. 5, line 66 to col. 6, line 6 and lines 58-59; from information in RAM 106, the information is retrieved and informed to the host device).

requesting the status of locks and bins (in fig. 6)

Art Unit: 2624

However, Nishiwaki does not teach requisition means for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user.

Mandel teaches requisition means for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user (in fig. 6 indicates the step of “does the user have a pre-assigned bin for this Mailbox/Fin.”; and step of “ will the new job fit entirely into this bin” and then step of “ Assign all sets to the user’s pre-assigned bin”).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printing system of Nishiwaki for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user as taught by Mandel. The suggestion for modifying the printing system of Nishiwaki can be reasoned by one of ordinary skill in the art as set forth above by Mandel because the modified printer of Nishiwaki would increase the efficiency of the printer for accepting the assigned bin from the user’s print job. The resultant system would have ability to perform either accepting the assigned bin from the user’s print job or assigning bin for the user’s print job.

As to claim 6, Nishiwaki teaches detecting papers stacked on the paper output place of the printer, and elimination means for eliminating information on the print job having used the corresponding paper output place from the memory means when the detection means detects that papers have been removed from the paper output place (in step of S1 in fig. 5 and col. 7, lines

31-37 describes that the data in table shows the bin is available when the bin contains no the printouts).

As to claim 7, Nishiwaki teaches the registration step or retrieval step is provided in the printer (col. 5, line 66 to col. 6, line 2).

As to claim 8, Nishiwaki teaches the registration step or retrieval step is provided in the host device (col. 6, line 3).

As to claims 9-12, Nishiwaki teaches the memory medium ROM (104 in fig. 2) which stores the program for instructing the steps in claims 5-8 as indicated above (col. 4, lines 19-21).

As to claims 13 and 14, due to the similarity of this claim to that of claim 1, this claim is rejected as the reasons applied to claim 1.

As to claims 15-25, due to the similarity of this claim to that of claim 1, this claim is rejected as the reasons applied to claims 2-3.

As to claim 26, the combination of Nishiwaki and Mandel teaches apparatus claim for performing the steps in claim 13 as indicated above.

As to claim 27, due to the similarity of this claim to that of claim 1, this claim is rejected as the reasons applied to claim 13.

Response to Arguments and Amendment

Applicant's arguments filed 3/20/03 have been fully considered but they are not persuasive.

Applicant asserted in page 11 "However, nothing has been found in Nishiwaki that teaches or suggests requisition means issuing a request of paper output place information, enabling to an specify a paper output place used in a designated print job, according to an

Art Unit: 2624

instruction by the user, and information means informing the user of paper output place information on the designated print job, obtained by the retrieval means, in response to the request by the requisition means, as recited in claim 1 “. In reply, Nishiwaki teaches a printing system in which a host device (2 in fig. 1) and a printer (6 in fig. 1) are connected via a communication medium and a print job produced in the host device is transferred to the printer to execute printing, comprising: Memory means (i.e., RAM) in which paper output place information (ID of selected bin 123) on the paper output place (bin 123) used in the print job is registered (col. 5, lines 65-67 and steps of S3 and S5; note: the print job is assigned with personal ID number to ID of selected bin 123, col. 6, line 47 and 57); Retrieval means (i.e., 101 in fig. 2) for retrieving paper output place information on a designated print job from the memory means; and Information means (i.e., 102 in fig. 2) for informing the paper output place information on the designated print job obtained in retrieving step, to the user, in response to issue of the request in the step of issuing the request (col. 5, line 66 to col. 6, line 6 and lines 58-59; from information in RAM 106, the information is retrieved and informed to the host device); requisition means for requesting the status of locks and bins (in fig. 6, the printer unit send inquiry signal to mailbox unit and receiving status of locks and bins).

However, Nishiwaki does not teach requisition means for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user.

Mandel teaches requisition means for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user (in fig. 6 indicates the step of “does the user have a pre-assigned

bin for this Mailbox/Fin.”; and step of “ will the new job fit entirely into this bin” and then step of “ Assign all sets to the user’s pre-assigned bin”).

Therefore, the suggestion for modifying the printing system of Nishiwaki can be reasoned by one of ordinary skill in the art as set forth above by Mandel because the modified printer of Nishiwaki would increase the efficiency of the printer for accepting the assigned bin from the user’s print job. The resultant system would have ability to perform either accepting the assigned bin from the user’s print job or assigning bin for the user’s print job.

Applicant asserted in page 13 “ That is, Nishiwaki transmits ID information, not requested or desired by the user, to the host, increasing needless data being exchanged in the printing system. This additional communication traffic decreases the efficiency and productivity of the entire printing system.” In reply, Mandel in combination with Nishiwaki teaches requisition means for issuing a request for paper output place information for enabling a user to specify a paper output place to be used in a designated print job, according to an instruction from the user (in fig. 6 indicates the step of “does the user have a pre-assigned bin for this Mailbox/Fin.”; and step of “ will the new job fit entirely into this bin” and then step of “ Assign all sets to the user’s pre-assigned bin”).

Therefore, the suggestion for modifying the printing system of Nishiwaki can be reasoned by one of ordinary skill in the art as set forth above by Mandel because the modified printer of Nishiwaki would increase the efficiency of the printer for accepting the assigned bin from the user’s print job. The resultant system would have ability to perform either accepting the assigned bin from the user’s print job or assigning bin for the user’s print job.

Art Unit: 2624

Furthermore, Mandel (US Patent No. 5,823,529) discloses the status of mailbox bins is full or almost full and tell user to select other bins.

For the above reasons, it is believed that the cited prior art fully discloses the claimed invention and the rejection stand.

Conclusion

Applicant's amendment with respect to independent claims 1-27 have been considered but are moot in view of the new ground(s) of rejection. This action is made **final**.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

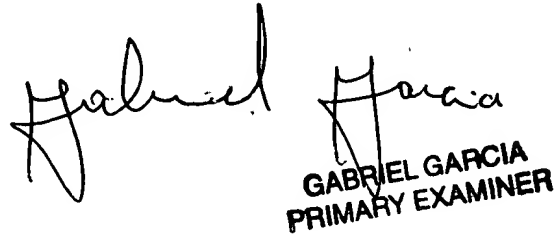
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Art Unit: 2624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
May 27, 2003


GABRIEL GARCIA
PRIMARY EXAMINER